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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,409	04/12/2000	Gregory M. Finn	FINN-002	5799
<div>7590      12/13/2007</div> <div>BRUCE G. BERNSTEIN 111 GLENWOOD ROAD M- MERION STATION, PA 19066</div>				
			EXAMINER GRAHAM, CLEMENT B	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/547,409	FINN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Clement B. Graham	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 1-21, has been deleted and claims 22-42 has been added.

2. **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant's claims are directed to an algorithm. Specifically, claim 1 recites "parsing", "plurality of accounts" "investors can buy and sell", graphical user interface" instruction to buy or sell";

However these steps are mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, for example) and abstract ideas without a practical application are found to be non-statutory subject matter. Therefore, Applicant's claims are non-statutory as they do not produce a useful, concrete and tangible result.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 22-42, are rejected under 35 U.S.C. 102(e) as being anticipated by Wallman U.S Patent 6, 161, 098.

As per claim 22, Lupien discloses an investment vehicle for enabling a plurality of investors to selectively buy and sell interests in each of a plurality of different individual securities traded on at least one financial market, comprising:

A programmed computerized data processing system:

a plurality of accounts for which the plurality of investors can buy and sell the interests in the plurality of securities, each of the accounts corresponding to at least one of the plurality of investors; and a graphical user interface.( see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39) and wherein, for each of the plurality of individual securities, interests in the security which are bought or sold by the at least one investor can correspond to a selected fractionalized market unit of the security .( see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39) and wherein the investment vehicle enables the investor to transmit to the investment vehicle orders to buy and sell the interests in the plurality of securities, each of the orders can include a plurality of limit requests, and each of the plurality of limit requests is a request to buy or sell interests in one or more of the plurality of securities upon the happening of a specific event or condition.(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 23, Lupien discloses wherein at least one of the plurality of limit requests is a request to buy or sell interests in more than one of the plurality of securities upon the happening of a specific event or condition. .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 24, Lupien discloses wherein the event or condition can relate to at least one of a market index, a change in a portfolio total value, a change in a portfolio weighted average value, a corresponding one of the plurality of accounts as a whole, and a corresponding one of the investors. .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 25, Lupien discloses wherein the event or condition can relate to something or someone unrelated to corresponding ones of the securities, a corresponding one of the

accounts, or a corresponding one of the investors. .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 26, Lupien discloses wherein the investment vehicle enables the investors to organize, using the graphical user interface, holdings in the corresponding accounts into one or more groups that can be defined by the investors to suit the investors' portfolio structuring desires. .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 27, Lupien discloses wherein the investor can specify an allocation factor for each security and for each group included in the account, the allocation factor for a group specifying a percentage of a total amount to be used to purchase interests in securities for the account, and the allocation factor for a security specifying a percentage of a total amount to be to be used to purchase interests in securities for the group in which the security is located, or if the security is not in a group, a percentage of the total amount to be used to purchase interests in securities for the account. .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 28, Lupien discloses wherein each of the investors is charged a fixed commission for each order that is accepted and acted upon by the investment vehicle on behalf of the investor, the commission being determined irrespective of the number of different securities that are involved with the order, the number of shares of each security involved in the order, the value of the investor's portfolio, and the fact that the order may include requests to both buy and sell interests in securities. .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 29, Lupien discloses wherein each of the securities involved in the order is allocated a percentage of the commission charged, the percentage being derived by dividing the value of the interest of each security purchased or sold by the total value of the interests of all the securities purchased or sold. .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 30, Lupien discloses wherein each of the investors is charged a fixed commission for each order that is accepted and acted upon by the investment vehicle on

behalf of the investor, the commission being determined irrespective of the number of shares of each security involved in the order, the value of the investor's portfolio, and the fact that the order may include requests to both buy and sell interests in securities. .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 31, Lupien discloses wherein each of the securities involved in the order is allocated a percentage of the commission charged, the Percentage being derived by dividing the value of the interest of each security purchased or sold by the total value of the interests of all the securities purchased or sold. .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 32, Lupien discloses wherein the graphical user interface provides the investors with dynamically re-configurable building blocks, each representing at least one of a security and a group of securities held in a corresponding one of the accounts, to enable the investors to build, re-configure and manage the accounts in a visually intuitive manner and to visually offer the investors portfolio information for the accounts.  
.(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 33, Lupien discloses wherein the investment vehicle enables the investors to organize, using the graphical user interface, holdings in the corresponding accounts into hierarchical, multi-tiered portfolio structures of one or more groups and subgroups that can be defined by the investors to suit the investors' portfolio structuring desires..(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 34, Lupien discloses wherein for each account, the corresponding investor can specify an allocation factor for each security, for each group and for each sub-group included in the account, the allocation factor for a group specifying a percentage of a total amount to be used to purchase interests in securities for the account in which the group is located, the allocation factor for a sub-group specifying a percentage of a total amount to be used to purchase interests in securities for the group in which the sub-group is located .(Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39)and the allocation factor for a security specifying a percentage of a total amount to be to be

used to purchase interests in securities for the group or sub-group in which the security is located, or if the security is not in a group or sub-group, a percentage of the total amount to be used to purchase interests in securities for the account in which the security is located. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 35, Lupien discloses wherein the investor can extend the account portfolio structure such that subgroups can themselves have subgroups. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 36, Lupien discloses where individual securities can reside at any tier level alongside groups and subgroups within the account portfolio. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 37, Lupien discloses wherein the investors can modify at least one of their corresponding account portfolio securities, groups, subgroups and allocation factors at any time after account set-up. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 38, Lupien discloses wherein the graphical user interface provides the investors with dynamically re-configurable building blocks, each representing at least one of a security, a group of securities, and a subgroup of securities held in a corresponding one of the accounts, to enable the investors to build, re-configure and manage the accounts in a visually intuitive manner and to visually offer the investors portfolio information for the accounts. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 39, Lupien discloses wherein the investor can specify for holdings in a corresponding one of the accounts percentages of the total value of the account to which the values of the holdings should correspond. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39) and wherein the investment vehicle reviews the investor's account and compares the holdings in the account with the specified percentages, and upon finding a discrepancy between the holdings and the specified percentages, which discrepancy is above a level set by the investor, notifies the investor of the

discrepancy. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 40, Lupien discloses wherein the investor can specify for securities and groups of securities in a corresponding one of the accounts percentages of the total value of the account to which the values of the holdings should correspond, and wherein the investment vehicle review the investor's account and compares the holdings in the account with the specified percentages, and upon finding a discrepancy between the holdings and the specified percentages, which discrepancy is above a level set by the investor notifies the investor of the discrepancy. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 41, Lupien discloses wherein the investor can specify for securities, groups of securities, and subgroups of securities in a corresponding one of the accounts percentages of the total value of the account to which the values of the holdings should correspond, and wherein the investment vehicle review the investor's account and compares the holdings in the account with the specified percentages, and upon finding a discrepancy between the holdings and the specified percentages, which discrepancy is above a level set by the investor, notifies the investor of the discrepancy. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

As per claim 42, Lupien discloses wherein the investors can modify at least one of their corresponding account portfolio securities, groups, and allocation factors at any time after account set-up. (Note abstract see column 2 lines 55-67 and column 4 lines 10-27 and lines 56-67 and column 6 lines 13-39).

## **CONCLUSION**

### **Response to Arguments**

6. Applicant's arguments filed on 9/29/2005 have been fully considered but are moot in view of new grounds of rejections.

7. Applicant's claims 22, 32, states "to selectively " **investor can buy and sell**" "**investor can correspond**" **investor to transmit**" **instruction to buy or sell**" re-configurable "

However the subject matter of a properly construed claim is defined by the terms that limit its



scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

\*\*>USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." ).<

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed.

Application/Control Number:  
09/547,409  
Art Unit: 3692

Page 9

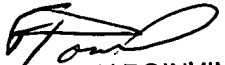
Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG  
DEC 5, 2007

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
